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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,894	04/01/2004	Bernd Luhmann	tesa 1631-WCG	9057
27386	7590	05/12/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			GORR, RACHEL F	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,894	LUHMANN ET AL.	
	Examiner	Art Unit	
	Rachel F. Gorr	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-1,5-27,9-7/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The abstract of the disclosure is objected to because it's too long. Correction is required. See MPEP § 608.01(b).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6, 10-14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grindley of GB 1,216,672 in view of Ganster.

4. Grindley discloses pressure sensitive urethane adhesives comprising triols having a molecular weight greater than 1000 and diols having a molecular weight less than 1000 (see example), and made at an NCO/OH ratio of 1/1. On page 2, col. 2, lines 113 - 120, he discloses aliphatic diisocyanate and the additives of the claims. He differs from the claims by listing aliphatic diisocyanate in a list with five aromatic diisocyanate, and he doesn't disclose a bismuth catalyst.

5. Ganster teaches that aliphatic diisocyanates are preferable for adhesives that contact the skin, and that bismuth catalysts are needed for adhesives made with aliphatic diisocyanates for skin contact (col. 1, lines 20-40 and col. 2, lines 1-20).

6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the aliphatic diisocyanate of Grindley in order to make adhesives suitable for skin contact, and to use the bismuth catalyst taught by Ganster as necessary for adhesives made from aliphatic diisocyanates for skin contact.

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7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grindley in view of Ganster and further in view of Clemens.

8. Grindley in view of Ganster show the invention of the claims (see above) but differ from these claims by not disclosing the use of polyols made in the presence of dimetal cyanide (DMC) catalysts.

9. Clemens teaches that polyurethane adhesives made from higher molecular weight polyols should be made with DMC polyols (col. 7, lines 20-60).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use DMC polyols in the invention of Grindley in view of Ganster because Clemens shows that this reduces the amount of mono-ols in the formulation and promotes the formation of urethane of higher molecular weight, which would have greater strength and be less soluble in solvents.

11. Claims 7-9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grindley in view of Ganster and further in view of Schumann of EP 1,095,993.

12. Grindley in view of Ganster show the invention of the claims (see above), but differ from these claims by not specifying the process of reacting the ingredients in a reaction nozzle onto a moving substrate.

13. Schumann, in the abstract, shows an apparatus for forming pressure sensitive adhesives by mixing the components in a nozzle then spray the formulation onto a moving substrate.

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14. It would have been obvious to one of ordinary skill in the art at the time the invention was made for Grindley to prepare his solventless pressure sensitive adhesive per the method of Schumann because Schumann shows a convenient and automatic way of preparing pressure sensitive adhesives on substrates.

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-3, 6-14 and 16-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/816,277. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims don't specify a bismuth catalyst in the urethane pressure sensitive adhesive. The structure of the resulting urethane adhesive would be the same regardless of the catalyst used.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 15 is objected to for depending on rejected claims.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel F. Gorr whose telephone number is 571-272-1072. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R.G.
May 10, 2005


RACHEL GORR
PRIMARY EXAMINER